

Application No. 10/049,488
Amendment dated March 20, 2009
After Final Office Action of December 23, 2008

5

Docket No.: 56925(71746)

REMARKS

Claim 9-19 and 21 are pending in the present application, as well as newly added claims 23 and 24 and are the subject of this Office Action. Claims 9, 17, 18, 19 and 21 have been amended. Claims 23 and 24 have been added. Support for the claims can be found throughout the specification including the Drawings and claims as filed originally. Support for the amendments may be found on page 6, lines 8 – 10 and page 8, lines 12 – 14. Claims 1-8, 20 and 22 have been canceled. No new matter has been added.

Applicants respectfully reserve the right to pursue any non-elected, withdrawn, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

Reconsideration and withdrawal of the rejections of this application in view of the remarks submitted herewith is respectfully requested, as the application is in condition for allowance.

Applicant now turns to comments made by the Examiner in this Office Action as follows.

OFFICE ACTION

1. Claims 9-19, 21 are rejected under 35 U.S.C. 103(a) as being obvious over Hughes 3,882,665.

The Examiner states, "Hughes teaches coating wire with plastic in an extrusion method, including a step of cooling the wire during the coating process (col. 7, lines 63-67). The wires are joined together in a strip 23 with apertures (sprockets) 24 (Figure 3). With respect to claim 22, plural plungers 19 on different axes inside different regions of second molded material 21 having a common core where walls 21 abut are adjacent to apertures 24. Note that in Figure 2, the wires 19 are shown protruding beyond the coatings 21. There are at least two reasons for coating the wires: a) to facilitate movement and adjustment of the wires (col. 1, lines 32-35)

BOS2 725601.1

Application No. 10/049,488
Amendment dated March 20, 2009
After Final Office Action of December 23, 2008

6

Docket No.: 56925(71745)

and b) to prevent corrosion by making the plastic very adherent to the wire (col. 2, lines 18-24). A primer is used to adhere the plastic tightly (col. 7, line 66- col. 8, line 5).

Hughes fails to teach that the wire (instant plunger) can slide in the coating (instant barrel).

It would have been obvious to omit the primer for adhering the plastic tightly to the wire if one were willing to forego the corrosion resistance of tight adherence of the plastic to the wire, for example, if one were drilling in a non-corrosive environment. See, e.g., MPEP 2144.04 IIA, reproduced below:

A. Omission of an Element and Its Function Is Obvious if the Function of the Element Is Not Desired
Ex parte Wu , 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon diluent. The claims were rejected over a primary reference which disclosed an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

It is the examiner's position that omission of the primer would result in a poorly adhered coating that would be moveable relative to the wire, thus satisfying the limitations of both the method and apparatus claims. While Hughes does not use the device as a plunger type pipette, it is structurally capable of such use (when the invention of Hughes is modified as described), e.g., by moving the central or other wires. There is no claim directed to the method of use.

BOS2 725601.1

Application No. 10/049,488
Amendment dated March 20, 2009
After Final Office Action of December 23, 2008

7

Docket No.: 56925(71745)

Applicants respectfully disagree. The inventive step in '488 is to apply this technology, not for the protection of the wire, but to use the two components – the polymeric layer and the metallic core – as the barrel and piston of a dispensing or aspirating device.

The essential test of obviousness would appear to hinge on whether it is apparent that by using a means of protecting a flexible or rigid wire with a polymeric coating and then introducing relative motion between the two components, a positive displacement pipette device can be realized. The claimed advantage of this invention is that a piston/barrel combination so formed can be made where the barrel closely conforms to the piston without the more usual need to machine one component to match the other or the subsequent need to assemble the two parts either manually or automatically. The piston/barrel combination is formed in a single operation with the bore of the barrel exactly conforming to the outer diameter of the piston.

In view of the above summary remarks and claim amendments, Applicants submit that all claims are allowable and respectfully request early favorable action by the Examiner. Applicant's representative would like to discuss this case with the Examiner to learn if any outstanding issues remain after consideration of this Amendment. If the Examiner believes that a telephone conversation with Applicants' attorney would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney of record.

FEE AUTHORIZATION

The within amendment is being filed concurrently with the filing and payment of the Request for Continued Examination (RCE). The Commissioner is authorized to charge the RCE fee and any other cost due in connection with the filing of this document to Deposit Account No. 04-1105, referencing docket no. 56925(71745).

BOS2 725601.1

Application No. 10/049,488
Amendment dated March 20, 2009
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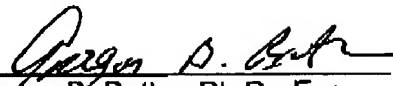
8

Docket No.: 56925(71745)

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Respectfully submitted,

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BOS2 725601.1